IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

APPLICANT: Kim Simelius

SERIAL NO: 10/645,687   FILING DATE: August 20, 2003

EXAMINER: Syed, Farhan M.   ART UNIT: 2165

ATTORNEY'S DOCKET NO.:   879A.0048.U1(US)

TITLE: METHOD AND APPARATUS FOR DATA TRANSMISSION

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REPLY BRIEF

This is paper is a reply brief responsive to the Examiner's Answer dated July 21, 2008. Applicant believes that no fee for filing this Reply Brief is due and no fee for an extension of time is due as this Reply Brief is being filed on or before the first business day after the federal holiday upon which the two month anniversary of the mail date of the Examiner's Answer falls. If there are any deficiencies in payment, please charge deposit account no.: 50-1924 for any deficiency.

(1)   STATUS OF CLAIMS

The final rejection of claims 1-22 is being appealed.

The status of the claims is as follows:

Claims allowed: none

Claims objected to: none

Claims rejected: Claims 1-22.

Claims canceled: none

(2)   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I.   Whether the Patent Office properly rejected Claims 1-22 under 35 U.S.C. 102(b) as being anticipated by Celik, U.S. Published Patent Application No. 2004/0236792.

II.   Whether the Patent Office properly rejected Claims 1-8, 12-20, and 22 under 35 U.S.C. 103(a) as being unpatentable over Alam, U.S. Patent No. 6,324,544, in view of Champagne, U.S. Published Patent Application No. 2005/0086199?

III.   Whether the Patent Office properly rejected Claims 9-11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Alam, U.S. Patent No. 6,324,544, in view of Champagne, U.S. Published Patent Application No. 2005/0086199, in view of Hunkins, U.S. Patent No. 6,141,663?

(3)   ARGUMENT

Arguments Directed to the Examiner's Answer dated July 21 2008

In the Examiner's Answer dated July 21 2008, the Examiner has withdrawn the rejection of claims 1-22 as being anticipated by Celik.

However, the Examiner has sustained the obviousness rejections based on Alam, Champagne, and Hunkins. All of these references describe synchronizing data files in separate systems or devices.

In the response to arguments section of the Examiner's Answer, pages 16-24, there are thirteen arguments. The first and second arguments relate to claims 1, 15, and 22.

Claim 1, recites, in pertinent part, as follows: "in response to said forming, providing to a user of the first electronic device a possibility to associate an existing grouping identifier with the formed data item."

Claim 15 recites "associating means for providing to a user of an electronic device a possibility to select an existing grouping identifier for the stored data item, for associating the stored data item with said existing grouping identifier in response to a situation in which the user selects said existing grouping identifier for the formed data item."

Claim 22 recites, in pertinent part, as follows: "computer program means for causing the first electronic device to provide to a user of the first electronic device a possibility to select an existing grouping identifier for the stored data item, computer program means for causing the first electronic device to associate the stored data item with said existing grouping identifier in response to a situation in which the user selects said existing grouping identifier for the formed data item."

In response to argument 1), Applicant requests that the Patent Office provide with particularity as by column (or, page) number and line numbers and/or drawing figure number and part number(s) in Alam and/ or Champagne where there is disclosure of "in response to forming," "a user," "the first electronic device," "a possibility," "an existing grouping identifier," and "the formed data item" in the context of "in response to said

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forming, providing to a user of the first electronic device a possibility to associate an existing grouping identifier with the formed data item." The passages cited by the Patent Office, namely column 4, lines 43-50, of Alam, and paragraph 0017 of Champagne do not seem to disclose or suggest this subject matter from claim 1.

In Applicant's invention, a user of an electronic device can associate a grouping identifier to at least one data file. Using these grouping identifiers a user defined synchronization of data files between two electronic devices can be accomplished either manually or automatically.

The Examiner uses Alam as the starting point in his reasoning. The system of Alam is depicted in Figures 1 and 6. The data items (i.e., program files) can be saved either in a desktop computer (14) or in a mobile device (12). Both the desktop computer and the mobile device comprise a PIM object store (20, 32) and a File object store (22, 34). The user of the system can save, delete, or add application program files in all of the depicted object stores (20, 32 and 22, 34).

The synchronization of the files between the object stores (20, 32, and 22, 34) is accomplished by utilizing Sync Engines (24, 36) in both depicted electronic devices (12, 14). However, the heart of the synchronizing process is the Synchronization Manager (148) and the Reference Store (150) of the Sync Engine (36) of the desktop computer (14).

The user of the desktop computer (14) can not control or make any changes in the depicted Reference Store (150). The Reference Store (150) comprises handles which are needed during the synchronization process. The Reference Store (150) is under the control of the Synchronization Manager (148) (column 10 lines 53-63). On column 11 on lines 44-48 it is also depicted that the Sync Engine (36) of the desktop (14) is responsible to determine which data items (i.e., files) in the PIM object store (20, 32) and/or File object store (22, 34) should be synchronized. The user of the desktop computer (14) can not determine which files should be synchronized.

On page 4, the Examiner gives his interpretation as to which parts of Alam corresponds to features of the invention recited in the claims. He also provides arguments regarding the depicted features of Champagne that could be used to correct deficiencies in the system of Alam.

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When rejecting the independent claims, the Examiner writes on page 4: *"The previous text clearly indicates that the associated reference store is in the forming of a data item for the first time into the first electronic device, which is the desktop."* We interpret this statement on page 4 so that the Examiner argues that the Reference Store (150) of Alam includes determinations (handles) which correspond to the grouping identifiers of Applicant's application. This is understandable because both determinations are used in a data file synchronization process.

The Examiner admits on page 4 that Alam does not teach a method to associate an existing grouping identifier (i.e., one handle in the Reference Store (150)) to a second formed data item in the PIM or File Object Store.

The Applicant argues that an existing data item (i.e., a handle in the Reference Store (150)) can be associated to only one data file in the PIM Object Store (20, 32) or in the File Object Store (22, 34). This is clearly depicted on column 11 on lines 14-29. It says: *"Each handle should contain data that uniquely identifies an object..."* and *"This data should be persistent and should not be reused for subsequently created objects."* Based on that, the Applicant argues that Alam teaches uncontested that a certain handle in the Reference Store (150) can be associated to only one data file either in the PIM object store or in the File object store. If it could be associated with several data items, the depicted synchronization process would be impossible.

The Applicant does not admit that Champagne would disclose features of Applicant's claimed invention. In paragraph 0008, it is stated that the depicted synchronization program requires little or no input from the user (i.e., the synchronization process is automated). Therefore, it is not presumable that some user actions could be taken from Champagne to guide at least partly "manual" synchronization in the system of Alam. And, as noted above, it is also evident that adding features, which the Examiner tries to introduce from Champagne (page 6), are against the basic teachings of Alam. Therefore, one of ordinary skill in the art would not combine the teachings of Champagne to the teachings of Alam to yield Applicant's claimed invention.

On this basis, Applicant submits that the Examiner's Answer does not present a solid chain of arguments that would justify the rejected claims.

As to argument 3), the Patent Office copied a question that it did not answer in a direct manner. Where does Champagne teach "a new grouping identifier?" Where does Champagne teach "a new grouping identifier formed by the user of the first device?" Where does Champagne teach that the grouping identifier is "retrieved from a network server?"

As to argument 4), claim 4 recites "maintaining a register of at least one grouping identifier being associable to at least one data item stored into a memory of the first electronic device." Where is the register in the cited passage of Champagne and, in the same passage of Champagne, what are the "at least one data item" and "the at least one grouping identifier?"

As to argument 5), where in the cited passage of Champagne (page 3, paragraph 0036) is manual selection by a user and that the selection is from a register?

As to argument 6), a user setting up an appointment and later notified automatically of the appointment does not correspond to "wherein said existing grouping identifier is automatically selected from the register by the first electronic device." A scheduled appointment on an electronic device would likely not be retrieved according to a grouping identifier since the grouping identifier (e.g., the word "work") of Applicant is meant to be visually recognized by a user whereas in the cited passage of Alam, when a comparison of current time to the scheduled time finds a match, a circuit may be switched on electronically without reference to a label.

As to argument 7), the cited passage of Champagne discloses a data structure is established. Perhaps data is later added to one or more records in the data structure. There is no teaching or suggestion of a "new grouping identifier" in this passage.

Also, regarding argument 7), Appellant notes that claim 19 is now separately argued from claim 7. The verb "create" implies coming into existence where there was no existence before. Applicant's disclosure supports this meaning. For example, in Appellant's Figure 1a, if a pre-existing identifier is not selected from a list 103, a new identifier is created 106.

As to argument 8), there is no teaching or suggestion in column 6, lines 54-66, of Alam, of an icon to be visually presented to a user of the first device. Just because there is disclosure of a pointing device 42 does not mean there is disclosure or implication of an icon. For example, a pointing device could be used to manipulate a browser toolbar only. Even if this passage of Alam could be construed to suggest an icon (Appellant does not admit this and argues against it), there would still not be a connection established between a grouping identifier and an icon.

As to argument 9), claim 13 recites the grouping identifier comprises text and claim 12 from which it depends recites the grouping identifier comprises an icon. The cited passage of Alam does not seem to teach or suggest the selected grouping identifier comprises an icon and text.

As to argument 10), claim 9 recites "wherein a user of the first electronic device selects the selected grouping identifier for the synchronization manually." The Patent Office cites as a pertinent teaching of Hunkins for this claimed subject matter. This passage discloses that common information may be updated manually. There seems to be no disclosure or suggestion of the subject matter recited in claim 9.

As to argument 11), even if Hunkins discloses that redundant data may be updated automatically, there is not disclosure or suggestion in Hunkins that "the first electronic device selects the selected grouping identifier for the synchronization automatically."

As to argument 12), Hunkins, column 8, lines 6-18, discloses synchronization at a scheduled time. A scheduled time does not necessarily mean periodically (i.e., at regular intervals).

As to argument 13), Hunkins in column 2, lines 49-53, discloses redundant data may be considered as islands of automation and that common information may be updated manually. There is no disclosure or suggestion in the passage of a "selecting means which is arranged to select the selected grouping identifier for the synchronization."

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REGARDING THE WITHDRAWAL OF CELIK IN REJECTING THE CLAIMS

Because it is not clear under the USPTO's Manual of Patent Examining Procedure if the USPTO may selectively withdraw a rejection from appeal and maintain the appeal, Appellant has retained the remarks previously made in the Appeal Brief regarding Celik. MPEP § 1207 seems to limit an examiner's course of action after receipt of an Appeal Brief to one of three options in which one option permits a new ground of rejection in an Examiner's Answer and in which none of the options seem to permit withdrawal of a ground of rejection in an Examiner's Answer. MPEP § 1207 states, in pertinent part, as follows:

> After an appeal brief under 37 CFR 41.37 has been filed and the examiner has considered the issues on appeal, the examiner may:
>
> (A) reopen prosecution to enter a new ground of rejection with approval from the supervisory patent examiner (see MPEP § 1207.04);
> (B) withdraw the final rejection and allow the application if the examiner determines that the rejections have been overcome and no new ground of rejection is appropriate; or
> (C) maintain the appeal by conducting an appeal conference (MPEP § 1207.01) and draft an examiner's answer (MPEP § 1207.02). Any examiner's answer mailed on or after September 13, 2004 may include a new ground of rejection (MPEP § 1207.03).

PROLOG

Please note that Celik, U.S. Published Patent Application No. 2004/0236792, had been cited by the Patent Office in rejecting claims 1-22 as a 35 U.S.C. 102(b) reference in the Final Office Action dated November 27, 2007. Celik was first applied as a 35 U.S.C. 102(b) reference in the June 29 2007 non-final office action. Appellant, as Applicant, discussed the inapplicability of Celik as a 35 U.S.C. 102(b) reference on pages 9-11 of the response filed September 13 2007. Certain points raised then were how Celik, Published Patent Application No. 2004/0236792, with a filing date of June 29 2004, could be a 35 U.S.C. 102(b) reference, or even any kind of prior art reference, against Appellant's invention as the filing date of Appellant's patent application is August 20,

2003. It was further argued that the Patent Office failed to treat all claim limitations using Celik, Published Patent Application No. 2004/0236792 (see page 11, lines 17-24, of the response filed on September 13, 2007). In reply to Appellant's September 13 2007 response, the Patent Office issued a Final Office Action dated November 27, 2007. On pages 19-20, of this Final Office Action, the Patent Office erroneously asserted that Celik, Published Patent Application No. 2004/0236792, is a valid 35 U.S.C. 102(b) reference as it is a continuation-in-part whose effective filing date makes it a 35 U.S.C. 102(b) reference over Appellant's application and that the grouping identifier is the unique user identifier and the data item is the personal information that is targeted to be synced as described in Figures 1, 2A, and 2B. Appellant felt compelled at this point to file a Request for a Pre-Appeal Brief Conference with a Notice of Appeal to correct the blatant errors in the persistence of the Patent Office in treating Published Patent Application No. 2004/0236792 as a 35 U.S.C. 102(b) reference and in insisting that the reference taught all the claimed subject matter of the claims. The Request for the Pre-Appeal Brief Conference Review contained two claims of clear error by the Patent Office in using Published Patent Application No. 2004/0236792: 1) a failure to treat all claim limitations and 2) misapplication of 35 U.S.C. 102(b) and failing to attribute significance to newly added subject matter in a continuation-in-part patent application.

Appellant does not believe that the other prior art rejection, based on Alam and Champagne, is a proper rejection. However, Appellant felt it necessary to single out discussion in the Pre-Appeal Brief Conference Review to Celik, Published Patent Application No. 2004/0236792, because the persistent use of this application to Celik was rather egregious and clearly disregarded proper application of 35 U.S.C. 102 and the Manual of Patent Examining Procedure.

The Notice of Panel Decision from Pre-Appeal Brief Review, mailed on April 2, 2008, states in item 2, in handwriting, "The 102 rejection over Celik will be withdrawn." Reference may be had to the February 27, 2008, Request for the Pre-Appeal Brief Review.

Upon receiving the Notice of Panel Decision from Pre-Appeal Brief Review, the Appellant called the examiner and asked if a new Office Action would be forthcoming. The examiner said no. The Appellant asked the examiner if there was a need to respond

to the rejection by Celik in the Appeal Brief. The examiner said no. 37 C.F.R. 1.2 may be especially pertinent here. In re Milton (Patent Petition 2007), concerning U.S. patent application serial no. 09/938,465, refers to 37 C.F.R. §1.2, which states that all business with the U.S. Patent and Trademark Office (USPTO) should be transacted in writing and that no attention will be paid to any alleged oral promise in relation to which there is disagreement or doubt. In in re Milton, the director of petitions rejected a patent attorney's petition for revival on the basis of an oral promise by the examiner.

37 C.F.R. 1.2 reads as follows:

> All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

A further problem, especially in light of Appellant's telephonic conversations with the examiner and the handwritten sentence of "The 102 rejection over Celik will be withdrawn," is that this quoted sentence from the Notice of Panel Decision from Pre-Appeal Brief Review does not specify a time frame for when the 102 rejection will be withdrawn. Since there is uncertainty when the 102 rejection will be withdrawn, and thus there is doubt, Appellant feels compelled to include discussion of the rejection by Celik, U.S. Published Patent Application No. 2004/0236792, within this Appeal Brief. Although pages 2-3 of the Examiner's Answer indicates that the rejection under Celik has been withdrawn, it is not clear that this procedure is permitted in light of MPEP § 1207.

ISSUE I

At issue is whether the Patent Office properly rejected Claims 1-22 under 35 U.S.C. 102(b) as being anticipated by Celik, U.S. Published Patent Application No. 2004/0236792.

For a claim to be anticipated, all non-inherent limitations must be found (usually) in a single reference (from MPEP 2131).

FAILURE TO TREAT ALL CLAIM LIMITATIONS

The Patent Office did not identify with specificity where in the prior art reference the claimed subject matter of both an "existing grouping identifier" and a "new grouping identifier" is disclosed.

Regarding the "grouping identifier" and "data item," the Patent Office asserted in lines 1-3 of page 20 of the Final Office Action dated November 27 2007 as follows: "The Examiner refers to Figures 1, 2A, and 2B. The grouping identifier is the unique user identifier and the data item is the personal information that is targeted to be synced as described in Figures 1, 2A, and 2B."

Does the Patent Office mean that the "ID Number" is the grouping identifier? If so, then how does Celik account for "an existing grouping identifier" as well as "a new grouping identifier?" And, how would one of ordinary skill select between the existing grouping identifier and the new grouping identifier? On page 3, lines 4-6, of the Final Office Action dated November 27 2007, the Patent Office asserted "selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping identifier, synchronizing said data items" as being taught by Celik, U.S. Published Patent Application No. 2004/0236792, presumably in Figure 2B (line 8, on page 3 of that Final Office Action).

Figure 2B of Celik shows '120' for 'Assign account and unique ID' and '130' for "Print business cards with IDs (barcode optional).' There does not appear to be any selection, as recited in the claims, between an "existing grouping identifier" and a "new grouping identifier."

The Patent Office, on pages 2-3, of the Final Office Action dated November 27 2007, refers to paragraphs [0041]-[0043] of Celik, U.S. Published Patent Application No. 2004/0236792, (same as col. 5, line 65 – col. 7, line 34 of the Celik's patent US6374259) with respect to the following features of the independent claims of the present application:

> *in response to a situation in which the user associates said existing grouping identifier for the formed data item, associating the formed data item with said existing grouping identifier, said existing grouping identifier being associable with at least one other data item, in response to a situation in which the user does not want to use said existing grouping identifier for the formed*

data item, obtaining a new grouping identifier and associating the formed data item with the new grouping identifier,

The Patent Office does not specify which feature or element recited in paragraphs [0041]-[0043] of Celik, U.S. Published Patent Application No. 2004/0236792, and that would correspond to the existing grouping identifier" and/or to "the new grouping identifier" recited in the above features.

Applicant could not find any other interpretation except that the Patent Office considers a "password" mentioned in the above passages of Celik, U.S. Published Patent Application No. 2004/0236792, as corresponding to the "existing grouping identifier" and/or to "the new grouping identifier" recited in the above features. In the paragraphs [0041]-[0043] of Celik, U.S. Published Patent Application No. 2004/0236792, the password is an element that can be established and changed by a user (changing = creating a new password that replaces an old one).

However, if the "existing grouping identifier" and/or "the new grouping identifier" recited in the above features are made to correspond to the password, the following features of the independent claims are not taught by Celik, U.S. Published Patent Application No. 2004/0236792, (added remarks are in brackets):

> *"selecting one of the following: said existing grouping identifier and the new grouping identifier, to be a selected grouping identifier* [when a new password is created it replaces the old one, therefore an "existing password" and a "new password" cannot not be available for selection], *and synchronizing said data items between said first electronic device and a second electronic device on the basis of said selected grouping identifier, said devices being capable of communication with each other*
> [Celik does not teach to synchronize electronic devices on the basis of a password]."

Therefore, Celik, U.S. Published Patent Application No. 2004/0236792, does not teach all the limitations of the independent claims of the present application. Hence, the teaching of Celik, U.S. Published Patent Application No. 2004/0236792, does not anticipate the independent claims.

As such, Celik, U.S. Published Patent Application No. 2004/0236792, cannot anticipate claims 1-22.

MISAPPPLICATION OF 35 USC 102(b) AND FAILING TO ATTRIBUTE SIGNIFICANCE TO NEWLY ADDED SUBJECT MATTER IN A CONTINUATION-IN-PART PATENT APPLICATION

The Patent Office first treated Celik, U.S. Published Patent Application No. 2004/0236792 as a 35 U.S.C. 102(b) reference and second did not separate out subject matter commonly disclosed by Celik, U.S. Published Patent Application No. 2004/0236792, but not disclosed by earlier patent applications from which Celik claims priority.

Celik, U.S. Published Patent Application No. 2004/0236792, is not a 35 U.S.C. 102(b) reference. It cannot be because it was not published or patented more than one year before the effective filing date of Applicant's patent application. **The effective filing date of a reference**, not the application being examined, **is irrelevant for the purposes of applying sub-section b) of 35 U.S.C. 102.**

MPEP § 706.02(a) states "If the publication or issue date of the reference is more than 1 year prior to the effective filing date of the application (MPEP § 706.02), the reference qualifies as prior art under 35 U.S.C. 102(b)." As Celik, U.S. Published Patent Application No. 2004/0236792, was not published until November 25 2004, it cannot be a 35 U.S.C. 102(b) reference against Applicant's current patent application.

As far as to whether U.S. Patent No. 6,374,529, may apply, the matter is moot as the Patent Office has not applied this reference.

Because, as the Patent Office correctly noted on page 19 of the Final Office Action dated November 27 2007, where Figures 1-8 of Celik, U.S. Published Patent Application No. 2004/0236792, and Figures 1-8 of Celik, U.S. Patent No. 6,374,259, form common subject matter, that commonly disclosed subject matter would be accorded the benefit of the filing date of the earlier of the two (i.e., Celik, U.S. Patent No. 6,374,259).

MPEP § 201.11 states as follows:

> Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. The statute is so worded that the prior application may contain more than the later-filed application, or the later-filed application may contain more than the prior application, and in either case the later-filed application is entitled to the benefit of the filing date of the

prior application as to the common subject matter disclosed in compliance with 35 U.S.C. 112, first paragraph.

As such, as pointed out on pages 9-10 of our response of September 17 2007, paragraphs 0065-0070 of Celik, U.S. Published Patent Application No. 2004/0236792, were newly added and so cannot qualify as prior art to reject the claims. Yet the Patent Office did just this for claims 8, 9, 10, 12, 20, and 21, in the Final Office Action dated November 27 2007.

The Notice of Panel Decision from Pre-Appeal Brief Review, mailed on April 2, 2008, states in item 2, in handwriting, "The 102 rejection over Celik, U.S. Published Patent Application No. 2004/0236792, will be withdrawn." No time frame for withdrawing the 102 rejection using Celik, U.S. Published Patent Application No. 2004/0236792, has been provided orally or in writing. The Pre-Appeal Brief Review Panel did consider the rejection based on Celik's published patent application to have met the USPTO's threshold as being "clear error."

The persistent misapplication of Celik, U.S. Published Patent Application No. 2004/0236792, has contributed to delaying the prosecution process. This delay in the prosecution process prejudices Applicant's efforts in obtaining a patent.

ISSUE II

At issue is whether the Patent Office properly rejected Claims 1-8, 12-20, and 22 under 35 U.S.C. 103(a) as being unpatentable over Alam, U.S. Patent No. 6,324,544, in view of Champagne, U.S. Published Patent Application No. 2005/0086199.

The independent claims of the present application recite the following features i) a formed data item is associated with a grouping identifier; ii) the grouping identifier is associable with at least one other data item for grouping the data items; iii) at least one grouping identifier is selected, and iv) data items between a first electronic device and a second electronic device are synchronized on the basis of the at least one selected group identifier.

CLAIMS 1- 22

The Patent Office asserts the solution recited in the independent claims of the present application are unpatentable in light of prior art publications Alam et al. (US 6324544) and Champagne (US 2005/0086199). The Patent Office asserts the same text passages of Alam and Champagne in rejecting the independent claims in the Final Office Action dated November 27 2007 as it did in the previous Office Action dated June 29 2007.

Claim 1 recites, in pertinent part, as follows:

> **in response to a situation in which the user associates said existing grouping identifier for the formed data item, associating the formed data item to said existing grouping identifier, said existing grouping identifier being associable with at least one other data item, in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item, obtaining a new grouping identifier and associating the formed data item to the new grouping identifier**

Claims 15 and 22 recite similar subject matter to the above portion of claim 1.

Furthermore, claim 1 recites "in response to said forming, providing to a user of the first electronic device a possibility to associate an existing grouping identifier with the formed data item."

The claimed subject matter of the independent claims makes possible that <u>a user</u> of an electronic device can form tailored grouping of data items. Neither Alam nor Champagne teaches the above-recited subject matter.

Alam (US 6324544) discloses a solution in which data can be synchronized between a first computing device and a second computing device in such a way that undesired duplicate data can be avoided, e.g., in a situation in which a file is renamed on the first (or second) computing device. This is based on determining whether a file (or like) already exists in a computing device under a different name after adding said file into said computing device and deleting the file with the different name if it existed.

Champagne (US 2005/0086199) discloses a solution for transferring records between databases that may have different organizations of data in records of databases. The organization of data in records is expressed with a quantity expressing the number of data fields in a record and with information characterizing the data fields. A data field is

characterized with "category" information that defines a type of information the field is meant to contain (e.g. a name of a person, an address, etc) and with "property" information that defines a format of data contained by the field (e.g. number of bits, integer, text, etc). In the solution disclosed by Champagne, a field map is established by correlating a plurality of data fields of a first database to a plurality of data fields of a second database using the above-mentioned information. Data synchronization between the first and the second database is performed using the field map.

The passages of Champagne cited by the Patent Office on pages 8-9 of the Office Action dated June 29 2007 are paragraphs 0036 and 0011.

Champagne discloses in paragraph 0036 as follows:

> [0036] The category of a field defines the type of information the field is designed or meant to contain. Databases are generally designed to store data for a particular application, for example, airline reservations, medical records, etc. In the case of personal information manager (PIM) applications, several types of databases are typically used, where the type of a database corresponds to the type of data stored in the database: appointments, "to do" lists, address books, expense records, general notes records, and e-mails. For these types of databases, a field identification protocol preferably provides a comprehensive list of field categories such that the fields of most, if not all, of commercially available PIM databases can be categorized according to the categories in the field identification protocol. (The same can also be done for other types of databases.) For example, in the case of an address book type database, the categories may include: name, last name, first name, middle initial, address, street name, city, state, home telephone number, business telephone number, etc. Then, for example, the record structure of remote database 32 may include a field that is of the category "name". The record structure of host database 12 may include equivalent fields of the categories "last name," "first name," and "middle initial," but not necessarily a field of the category "name". In other embodiments, the field identification protocol provides a list of field categories for a selected group of databases or for those databases designed to conform to the protocol.

Champagne discloses in paragraph 0011 as follows:

> [0011] In a third aspect, in order to transmit data between two databases, information identifying the record structure of one of the two databases is transmitted to a computer program. This

transmitted information identifies both the categories and the properties of a plurality of fields of the record structure of one of the two databases. Data stored in a plurality of fields of a plurality of the records of the first database is then transmitted from one of the two databases to the other one of the two databases. The transmitted data is then processed using the identifying information.

The categories of Champagne, at least from paragraphs 0011 and 0036, appear to be static in number. Champagne, at least in these passages, does not disclose obtaining a new category. The currently pending claims recite that a new grouping identifier may be obtained. That new grouping identifiers can be obtained/ created in conjunction with storing data items opens a door for a tailored grouping of data items that, according to Applicant's understanding, is not disclosed or made obvious by the prior art of record.

In particular, the Patent Office refers to paragraph [0011] of Champagne with respect to the following feature of the independent claims of the present application:

> *in response to a situation in which the user does not want to use said existing grouping identifier for the formed data item, obtaining a new grouping identifier and associating the formed data item with the new grouping identifier*

The paragraph [0011] of Champagne recites:

> [0011] *In a third aspect, in order to transmit data between two databases, information identifying the record structure of one of the two databases is transmitted to a computer program. This transmitted information identifies both the categories and the properties of a plurality of fields of the record structure of one of the two databases. Data stored in a plurality of fields of a plurality of the records of the first database is then transmitted from one of the two databases to the other one of the two databases. The transmitted data is then processed using the identifying information.*

The above citation of Champagne does not teach to obtain a new grouping item and to associate a formed data item with the new grouping item as a response to a situation in which a user does not want to use an existing grouping identifier for the formed data item. The Patent Office states in page 8, lines 5-8, of the Final Office Action dated November 27, 2008: *"The preceding text clearly indicates that synchronizing data is transmitting data from the first electronic device, which is the first database, and*

second electronic device, which is the second database, based on the selected identifier, which is the identifying information." Hence, not even the Patent Office argues that the above citation of Champagne would teach to obtain a new grouping item and to associate a formed data item with the new grouping item as a response to a situation in which a user does not want to use an existing grouping identifier for the formed data item. Therefore, the disclosures of Alam and Champagne do not separately or as a combination lead a person skilled in the art to a solution recited in the independent claims.

On the basis of the above-mentioned facts the Office Action does not present a solid chain of arguments that would justify the claim rejections.

Therefore, the disclosures of Alam and Champagne do not separately or as a combination lead a person skilled in the art to a solution that enables a user of an electronic device to form tailored grouping of data items and the solution recited in the proposed amended is not taught or made obvious by Alam and Champagne.

Thus, claims 1-8, 12-20, and 22 are allowable over the combination of Alam and Champagne.

CLAIM 3

Claim 3 recites "a method according to claim 1, wherein the new grouping identifier is formed by the user of the first electronic device or the new grouping identifier is retrieved from a network server."

Where does Champagne teach "a new grouping identifier" and "a new grouping identifier formed by the user of the first device" or "retrieved from a network server?" These elements do not appear to be found in paragraph 0036 of Champagne, cited by the Patent Office.

As such, claim 3 and its dependent claims 5-7 are allowable over Alam in view of Champagne.

CLAIMS 4, 8, 16, AND 20

Claim 4 recites "a method according to claim 1, wherein the method further comprises maintaining a register of at least one grouping identifier being associable to at least one data item stored into a memory of the first electronic device."

The Patent Office asserted that paragraph 0036 of Champagne teaches this subject matter. However, what is the "register" and what is the "at least one grouping identifier" in this passage?

Barring such disclosure and also barring disclosure of "at least one grouping identifier being associable to at least one data item stored into a memory of the first electronic device," claim 4 and its dependent claim 8 are allowable over Alam in view of Champagne.

For similar reasons as to the allowability of claims 4 and 8, claims 16 and 20 are allowable.

CLAIMS 5 AND 17

Claim 5 recites "a method according to claim 3, wherein said existing grouping identifier is manually selected from a register by the user of the first electronic device."

As with intervening claim 3, where does Champagne teach "a new grouping identifier" and "a new grouping identifier formed by the user of the first device" or "retrieved from a network server?" Furthermore, where does Champagne disclose or suggest an "existing grouping identifier is manually selected from a register by the user of the first electronic device?"

Barring such disclosure, claim 5 is allowable over Alam in view of Champagne.

For similar reasons as to the allowability of claim 5, claim 17 is allowable.

CLAIMS 6 AND 18

Claim 6 recites "a method according to claim 3, wherein said existing grouping identifier is automatically selected from the register by the first electronic device."

As with intervening claim 3, where does Champagne teach "a new grouping identifier" and "a new grouping identifier formed by the user of the first device" or "retrieved from a network server?" Furthermore, where does Champagne disclose or suggest an "existing grouping identifier is automatically selected from a register by the user of the first electronic device?"

Barring such disclosure, claim 6 is allowable over Alam in view of Champagne.

For similar reasons as to the allowability of claim 6, claim 18 is allowable.

CLAIM 7

Claim 7 recites "a method according to claim 3, wherein the new grouping identifier is formed by a user of the first electronic device."

The cited passage of Champagne, abstract, does not disclose that a user of the first electronic device forms the new grouping identifier. Someone or something else could do this.

As such, claim 7 is allowable over Alam in view of Champagne.

CLAIMS 12 AND 14

Claim 12 recites "a method according to claim 1, wherein the selected grouping identifier comprises an icon to be visually presented to a user of the first device."

The Patent Office asserted that Alam, in column 6, lines 54-66, teaches claim 12. However, Alam does not recite an icon in the cited passage or elsewhere in Alam and does not show an icon. The disclosure of a pointing device 42 in this passage of Alam does not disclose or imply an icon since a pointing device could select from a menu or tool bar and not an icon. Thus, claim 12 and its dependent claims 13 and 14 are allowable over Alam in view of Champagne.

CLAIM 13

Claim 13 recites "a method according to claim 12, wherein the selected grouping identifier further comprises text to be visually presented to the user of the first device."

The Patent Office asserted that Alam teaches claim 12 in column 6, lines 54-66; however, Alam does not disclose the selected grouping identifier further comprises text to be visually presented to the user of the device.

Thus, claim 13 stands alone and is allowable over Alam in view of Champagne.

CLAIM 19

Claim 19 recites "wherein said associating means are further arranged to create the new grouping identifier on the basis of input of a user of the electronic device."

The verb "create" implies coming into existence where there was no existence before. Applicant's disclosure supports this meaning. For example, in Figure 1a, if a pre-existing identifier is not selected from a list 103, a new identifier is created 106.

The cited passage of Champagne, abstract, does not disclose that a user of the first electronic device creates the new grouping identifier. Someone or something else could do this.

As such, claim 19 is allowable over Alam in view of Champagne.

ISSUE III

At issue is whether the Patent Office properly rejected Claims 9-11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Alam, U.S. Patent No. 6,324,544, in view of Champagne, U.S. Published Patent Application No. 2005/0086199, in view of Hunkins, U.S. Patent No. 6,141,663.

Hunkins does not cure the above noted deficiencies of Alam and Champagne.

Hunkins shows, in Figure 3, that for external systems are updated and synchronized. These four external systems are PBX 11, Directory 12, Call Accounting 13, and Voice Mail 14.

The Patent Office asserted that column 2, lines 49-53, column 4, lines 12-16, and column 8, lines 6-18, of Hunkins to provide teachings that disclose the subject matter of claims 9-11 and 21.

Hunkins, column 2, lines 49-53, recites as follows:

> Manual Update. Each of the databases containing redundant data can be viewed as islands of automation. Information that is common to all can be updated by manually entering the information into each of the separate databases. This is an extremely common method. The greatest disadvantage is that the amount of work necessary for one change is multiplied for each database containing the redundant data to be updated. Consequently, a large human error factor is introduced and it is difficult if not impossible to have all of the redundant data perfectly synchronized.

Hunkins, column 4, lines 12-16, recites as follows: "It is an object of the present invention to allow redundant data to be updated automatically, without human intervention, in order to provide and preserve data integrity and synchronization."

Hunkins, column 8, lines 6-18, recites as follows:

> When the scheduled time is reached, the preferred embodiment begins processing each Change Object one by one. Each Change

Object is asked for its database references. With this information, all available Format files, like those listed in 1c are scanned to see if the changed data is also appearing in an outside data file. If it is, the external data file is located with the link file as shown 1e and the Format file is used to surgically update the external data file. Since the complete format is now known, this is a manageable problem. When the project file is completed and all Change Objects have been executed, all external data files are synchronized to the common database.

As none of these cited passages of Hunkins discloses selecting the selected grouping identifier for synchronization manually, periodic synchronization, or selecting the selected grouping identifier for the synchronization on the basis of input of a user of the electronic device, claims 9-11 and 21 are allowable over Alam in view of Champagne and further in view of Hunkins.

CLAIM 9

Claim 9 recites "a method according to claim 1, wherein a user of the first electronic device selects the selected grouping identifier for the synchronization manually."

There does not appear to be any disclosure or suggestion of a first device selecting the selected grouping identified for the synchronization manually. Hunkins, in column 2, lines 49-53, does not appear to disclose or suggest selecting the selected grouping identifier. Hunkins, in column 2, lines 53-58, teaches away from manual updating also since it is consider to update databases containing redundant data.

Thus, claim 9 is allowable over Alam in view of Champagne and further in view of Hunkins.

CLAIM 10

Claim 10 recites "a method according to claim 1, wherein the first electronic device selects the selected grouping identifier for the synchronization automatically."

Hunkins discloses in column 4, lines 12-16, that it is an object of his invention to allow redundant data to be updated automatically. However, Hunkins does not teach in this cited passage that the first device selects the selected grouping identifier for the synchronization automatically.

Thus, claim 10 is allowable over Alam in view of Champagne and further in view of Hunkins

CLAIM 11

Claim 11 recites "a method according to claim 1, wherein the first electronic device performs the synchronization periodically."

Hunkins, in column 8, lines 6-18, the passage relied upon by the Patent Office for a teaching for claim 11, does not disclose periodic synchronization but a scheduled synchronization. A scheduled synchronization, even if done a plurality of times, is not necessarily periodic.

Thus, claim 11 is allowable over Alam in view of Champagne and further in view of Hunkins

CLAIM 21

Claim 21 recites "a device according to claim 15, wherein said selecting means are further arranged to select the selected grouping identifier for the synchronization on the basis of input of a user of the electronic device."

Hunkins, column 2, lines 49-53, discloses as follows: "Manual Update. Each of the databases containing redundant data can be viewed as islands of automation. Information that is common to all can be updated by manually entering the information into each of the separate databases. This is an extremely common method." There is no disclosure of selecting means arranged to select the grouping identifier in this passage.

Thus, claim 21 is allowable over Alam in view of Champagne and further in view of Hunkins
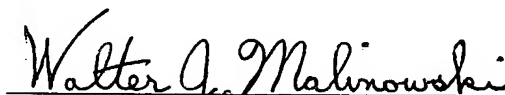
For the reasons provided above, it is respectfully submitted that the Patent Office has failed to establish a prima facie case of obviousness.

CONCLUSION

For the above reasons, it is respectfully requested that in each of the rejections discussed herein under 35 U.S.C. § 103(a) (and 35 U.S.C. § 102(b)), the Patent Office has failed to meet the burden in establishing a prima facie basis for the rejections of Claims 1-22. Accordingly, reversal of all outstanding rejections is earnestly solicited.

Respectfully submitted,

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